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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,344	07/06/2001	Craig S. Caldwell	30905	4930

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,344

Applicant(s)

CALDWELL ET AL.

Examiner

Matthew O Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 7-10, 13, and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning the last two lines of claims 1 and 7, it is unclear as to what structural arrangement "wherein the return side filter and the supply side filter share a common housing component."

Regarding claims 2 and 8, it is unclear as to what particle size "relatively small particulates" implies.

As to claims 3 and 9, it is unclear as to what particle size "relatively large particulates" implies.

Concerning claims 4 and 10, it is uncertain as to what structure the term "bottom" implies.

Concerning lines 2 and 3 of claims 13 and 14, it is unclear as to what proportion "predominantly" implies.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-10, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Beer.

With respect to claim 1, Beer discloses a filtration assembly (see the drawing Figure) including a return-side filter 101 including a return side inlet 100, a return side outlet (e.g., defined by the apertures of the filter housing shown in FIG. 1), and a return side filter media (e.g., the serially disposed fine porosity pleated filters shown in FIG. 3) interposed between the return side inlet and outlet, a supply side filter 106 including a supply side inlet 108 and a supply side outlet 109 and a supply side filter media 105 interposed between the supply side inlet and outlet, the return side filter and the supply side filter sharing a common housing component (e.g., the cover 113, or the lower pan element shown in FIG. 1).

With respect to claim 7, Beer discloses a vehicle transmission with a fluid circulating therethrough (see the title section of the abstract), a sump (e.g., defined by the lower pan shown in FIG. 1) operable to receive fluid via a sump inlet (e.g., defined by the transmission), provide a reservoir for the fluid, and release fluid through a sump outlet (e.g., defined by the transmission), and a filtration system including a return-side filter 101 including a return side inlet 100 coupled to the sump inlet, a return side outlet (e.g., defined by the apertures in the housing of the filter 101 shown in FIG. 1), and a return side filter media (e.g., the serially disposed fine pleated filters shown in FIG. 3) interposed between the return side inlet and outlet, a supply side filter 106 including a

supply side inlet 108 and a supply side outlet 109 coupled to the sump outlet, and a supply side filter media 105 interposed between the supply side inlet and outlet, the return side filter and the supply side filter sharing a common housing component (e.g., the cover part 113, or the lower pan element shown in FIG. 1).

Concerning claims 2 and 8, Beer discloses the return filter side media as being operable to filter relatively small particles from the return fluid since it includes two serially disposed fine porosity pleated filters (see FIG. 3).

As to claims 3 and 9, Beer discloses the supply side filter media as being operable to filter only relatively large particulates from the supply since it is associated with the coarse suction screen filter shown in FIG. 3.

Concerning claims 4 and 10, Beer discloses the common housing component (e.g., the lower pan element shown in FIG. 1 as being a bottom.

Regarding claims 13 and 14, Beer discloses the return side media as being capable of removing particles of a first size smaller than particulates of a second size removed by the supply side media since the return side media includes fine porosity pleated filters whereas the supply side filter includes a coarse screen.

Applicant's arguments filed 5-5-03 have been fully considered but they are not persuasive.

With respect to the argument against the rejections under 35 U.S.C. 112, second in which it was held that it was unclear as to what structural arrangement "wherein the return side filter and the supply side filter share a common housing component" implies

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in claims 1 and 7 and as to what structure the term "bottom" implies in claims 4 and 10, applicants argument that the limitations are definite since they have basis in the specification is not deemed persuasive or responsive since the rejections pertains to the clarity and definiteness of claim limitations rather than the question as to whether or not such limitations have basis in the specification. It is noted that the term "shares" used in claims 1 and 7 implies an indefinite range of structural arrangements and is considered inappropriate since the common housing component is not disclosed to be separate and distinct of the structure defining the supply side and return side filters. It is further noted that the term "bottom" used in claims 4 and 10 is inappropriate since it implies the position of an element rather than structure.

With respect to the arguments against the rejection under 35 U.S.C. 112, second paragraph in which it was held that it was unclear as to what particle size "relatively small particulates" implies in claims 2 and 8 and as to what particle size "relatively large particulates" implies in claim 3 and 9, the rejections have been maintained since the claims include no point of reference to determine what size "relatively small" and "relatively large" implies.

Applicant's arguments against the rejections under 35 U.S.C. 102(b) over O'Connor and 35 U.S.C. 103 over O'Connor in view of Agner are moot in view of the new grounds of rejection listed above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is 703-308-3854. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda W. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Matthew O Savage
Primary Examiner
Art Unit 1723

mos
July 10, 2003